



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

IP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/125,635	08/21/98	MELTZER	P 4239-50420

KLARQUIST SPARKMAN CAMPBELL
LEIGH & WHINSTON
ONE WORLD TRADE CENTER
121 SW SALMON STREET SUITE 1600
PORTLAND OR 97204-2988

HM22/0830

EXAMINER

BASIN

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED:

08/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/125,635

Applicant(s)

Meltzer et al

Examiner

Nirmal. S. Basi

Group Art Unit

1646



☒ Responsive to communication(s) filed on May 30, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12-45 and 47-65 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 12-45 and 47-65 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

1. Reply to restriction requirement filed 5/30/00 has been entered. A restriction requirement was made in error. A new lack of unity of invention is presented below:

Election/Restrictions

5 2 Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

10

Group I. Claims 55-65 (substantially the same as original claims 1-11) , drawn to DNA comprising a sequence encoding the A1B1 polypeptide, and cells comprising said polynucleotide, and DNA that hybridizes to said polynucleotide

15

Group II. Claims 12-13, drawn to a substantially purified polypeptide comprising SEQ ID Nos: 2, 3, 4 or 8.

Group III. Claims 41 drawn to antibody classified in class 435, subclass 6, for example antibody.

20

Group IV. Claims 14-21, 26-27 drawn to a method of identifying a candidate compound which inhibits estrogen receptor (ER)-dependent transcription

Art Unit: 1646

comprising contacting the compound with the A1B1 polypeptide of claim 12.

5 Group V. Claims 22-25 and 28-31, drawn to method of detecting an aberrantly proliferating cell in a tissue sample comprising determining the level of expression of a polynucleotide encoding A1B1 polypeptide of claim 12. Claim 23, although depending on claim 21, has been included in this Group because it appears that claim 23 should depend on claim 22. There is a lack of antecedent basis for claim 23 in claim 21, there is antecedent basis for claim 23 in claim 22.

10 Group VI. Claims 32-40 and 53-54, drawn to method of reducing proliferation of a cancer cell in a mammal comprising administering to the mammal a compound which inhibits expression of A1B1 of claim 12 or a polynucleotide encoding the A1B1 polypeptide of claim 12.

15 Group VII. Claims 42-44, drawn to method of identifying a tamoxifen-sensitive patient, comprising contacting a patient with tamoxifen and determining the level of A1B1 gene expression.

 Group VIII. Claims 45 and 47-52 drawn to transgenic animal wherein at least one copy of the A1B1 gene encoding the A1B1 polypeptide of claim 12 or of the pCIP gene has been functionally altered.

Art Unit: 1646

3. The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventive concept of an A1B1 gene (see Abstract) has been disclosed by Xin-Yuan Guan et al (see IDS, Cancer Research, 56:3446-3450 (August 1, 1996)). Because the special technical feature of Group I has been found in the prior art, a technical relationship does not exist between the claimed groups. Therefore, unity of invention is lacking. The products of Groups I-VIII do not share the same technical feature because they are drawn to products having materially different structures and functions, each defines a separate invention over the art.

10 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

10

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15

Nirmal S. Basi
Art Unit 1646
August 28, 2000


YVONNE EYLER, PH.D
PRIMARY EXAMINER